

Remarks

The present application includes claims 1-8. Claims 1-8 have been rejected by the Examiner.

Claims 1-8 were rejected under 35 U.S.C. 103(a) as unpatentable over Yoseloff et al. (U.S. Patent No. 6,471,208) in view of Nagao (U.S. Patent No. 5,423,539). Applicant respectfully traverses the Examiner's rejection for at least the following reasons.

Yoseloff relates to a multi-part or segment game wherein the player participates in a first segment based on wager and participates in a second segment based on a predetermined qualifying outcome in the first game. See, e.g., Abstract and col. 3, line 20 – col. 4, line 2. The second segment randomly determines a determined factor that is used to award the player a second payout that is equal to the determined factor multiplied by one or more of a) the wager placed to participate in the game; b) the first payout amount; and c) the wager placed to participate in the game and the first payout amount. See, e.g., Abstract and col. 3, line 20 – col. 4, line 2.

As stated by the Examiner, Yoseloff et al. fails to disclose any specific arrangement of scatter or special symbols on the reels used by their gaming device, and more specifically, lack disclosing that "in respect of at least one of the reels, the set comprising a plurality of the special symbols, the positions of at least certain of the special symbols on the at least one reel being separated from each other on the reel by no more than one other symbol position, so that, when more than one of the special symbols of the at least one reel are displayed simultaneously with special symbols on any of the

other reels when the reels are in rest condition, all of the displayed special symbols contribute to a single paying combination of the special symbols."

Nagao relates to a game machine with a substitutable character used in a combination of characters along one of three winning lines. See, e.g., Abstract and col. 1, lines 59-68. The Applicant submits that the Examiner's assertion that Nagao could allow the 1-BAR symbol to be replaced by a scatter symbol is not illustrative of anything other than the fact that previous games included like symbols next to (or near) each other on a reel strip of a gaming machine. There is no teaching or suggestion in Nagao that the game might be awarding wins that do not rely on a payline, or that more than one 1-BAR symbol on the same reel strip could contribute to the same winning combination. Moreover, there is no suggestion that a win might be awarded for a combination of symbols that includes more symbols than there are reels on the machine.

Furthermore, in response to the Examiner's assertion that Yoseloff discloses a scatter pay feature for the occurrence of at least three special symbols on the 5x3 symbol matrix, the Applicant respectfully submits that the subject matter of the pending claims goes beyond merely adding more scatter symbols to some or all of the reels of a gaming machine to increase the frequency of scatter wins. In particular, the pending claims recite a system that includes the following:

1. First, it has a particular arrangement of symbols on its reel strips such that on at least one of the reels some of the scatter symbols are "separated from each other on the reel by at most one symbol"; and

2. Second, the game determines outcomes such that "when more than a minimum number of scatter symbols are displayed simultaneously at any one time when the reels

are in a rest condition, all the displayed scatter symbols contribute to a single paying combination of the scatter symbols.

The result of the particular arrangement of scatter symbols chosen by the inventors, and as highlighted by point 1 above, is that more than one scatter symbol on the same reel can be displayed at once. When this unique feature is combined with the new winning criterion of point 2, it produces a game having outcomes that are substantially different to from the prior art.

First, it may result in an increase in the frequency of scatter symbols wins (due to a possible increase in the number of scatter symbols on the reel strips). Second, the pending claims open up a new range of scatter symbol wins that have not previously existed, namely a type of scatter win in which the number of symbols contributing to the win exceed the number of reels, e.g. winning on up to 15-a-kind scatter symbols on a 5 reel game with 3 visible symbol positions. Third, it opens up winning combinations where vertically aligned symbols contribute in the same winning combination (i.e., symbols on the same strip) rather than different winning combinations.

The Examiner might contend that the feature of all displayed scatter symbols contributing to a prize award is a standard feature of scatter symbol games. However, such an argument ignores the fact that prior art games were not able to display more than one *scatter or special* symbol per reel, so the issue of how to deal with multiple scatter symbols displayed on the same reel was not considered. Moreover, it is noted that prior gaming machines such as the "Bally Circus" which had physically spinning reels did not have the ability to simultaneously count multiple scatter symbols on one reel. Neither

Yoseloff nor Nagao provide such disclosure. To impart such teaching to either Yoseloff or Nagao simply imparts the benefit of hindsight into their disclosures.

Furthermore, includes of a scatter or special symbol goes beyond use of “just another indicia on the reel strip similar to any other indicia on the reel strip.” Rather, the “scatter symbol” or “special symbol” of the pending claims is given special consideration in the logic of the game being played at the gaming machine and provides different visual and entertainment value to the player. Introduction of the symbols affect the game being provided, the chances of winning, and the configuration of the gaming machine, among other things. The special or scatter symbols help determine what is won. These elements are not disclosed by either Yoseloff or Nagao. Therefore, their combination lacks disclosure of these elements and does not render them obvious to try.

It is well established that an examiner is not permitted to use an improper hindsight reconstruction of the claimed invention in rejecting the claims. Use of hindsight analysis has been specifically condemned by the Federal Circuit:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification ... Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This Court had previously stated that “one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

In Re John Fritch, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992). See also *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1135, 1143 n.5, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986); MPEP 2141.

The Applicant respectfully submits that claims 2 to 5 and claim 7 are patentable at least due to their dependence on their respective independent claims. Claims 3 to 5 further specify arrangement of scatter symbols that might be advantageous in certain embodiments of the present invention. These arrangements of scatter symbols, particularly that of claim 5, highlight the types of outcomes that are possible with embodiments of the present invention, but are not possible with the prior art.

Thus, for at least the reasons recited above, the Applicant respectfully submits that independent claims 1, 6 and 8 and dependent claims 2-5 and 7 should be allowable over the cited art of record.

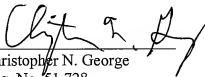
CONCLUSION

It is submitted that the present application is in condition for allowance and a Notice of Allowability is respectfully solicited. If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited and encouraged to contact the Applicant at the number below.

The Commissioner is authorized to charge any additional fees or credit overpayment to the Deposit Account of MHM, Account No. 13-0017.

Respectfully submitted,

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Christopher N. George
Reg. No. 51,728

McAndrews, Held & Malloy, Ltd.
500 W. Madison Street
34th Floor
Chicago, IL 60661
Phone (312) 775-8000
Fax (312) 775-8100